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In re Application of

Dyck et al.

Application No.: 09/646,110

PCT No.: PCT/CA99/00250

Int. Filing Date: 25 March 1999

Priority Date: 26 March 1998

Attorney's Docket No.: 10242-034

For: ALIPHATIC AMINO CARBOXYLIC AND
AMINO PHOSPHONIC ACIDS, AMINO NITRILES
AND AMINO TETRAZOLES AS CELLULAR
RESCUE AGENTS

DECISION ON

REQUEST UNDER

37 CFR 1.42

This is a decision on the papers filed 26 February 2001 which are being treated as a request under 37 CFR 1.42.

BACKGROUND

On 25 March 1999, applicants filed international application PCT/CA99/00250, which claimed priority of two earlier United States provisional applications filed 26 March 1998. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 30 September 1999. A Demand for international preliminary examination, in which the United States was elected, was filed on 14 October 1999, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 26 September 2000.

On 26 September 2000, applicants filed a transmittal letter for entry into the national stage in the United States which was accompanied by, *inter alia*, the requisite basic national fee as required by 35 U.S.C. 371(c)(1) and a preliminary amendment.

On 13 November 2000, the United States Patent and Trademark Office in its capacity as an Elected Office mailed the "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" (Form PCT/DO/EO/905) indicating that applicant was required to file an oath/declaration and a surcharge fee.

On 16 January 2001, applicants filed executed declarations for inventors Dyck, Davis, Liu, Durden and Bouton. Since inventor Paterson is deceased, applicants filed a declaration executed by his legal representative, The Canada Trust Company as well as the Letter Probate of the Last Will and Testament. Applicants also filed an assignment, a power of attorney executed by the inventors and the legal representative for Mr. Paterson, a petition and the fee for a one-month extension of time, and the Initial Information Data Sheet.

On 01 February 2001, the United States Patent and Trademark Office in its capacity as an Elected Office mailed the "NOTIFICATION OF DEFECTIVE RESPONSE" (Form PCT/DO/EO/916) and the "NOTIFICATION OF DEFECTIVE OATH OR DECLARATION" (Form PCT/DO/EO/917) indicating that the declaration did not comply with 37 C.F.R. 1.497(a) and (b) and 37 CFR 1.63.

On 26 February 2001, applicants filed the current response indicating that the Declaration submitted on January 12, 2001 does comply with 37 CFR 1.63 since an Initial Application Data Sheet was also submitted.

DISCUSSION

Applicant's declarations filed 16 January 2001 should have been treated as a request under 37 CFR 1.42. Therefore, the "NOTIFICATION OF DEFECTIVE RESPONSE" (Form PCT/DO/EO/916) and the "NOTIFICATION OF DEFECTIVE OATH OR DECLARATION" (Form PCT/DO/EO/917) were mailed in error.

With respect to applicants' declarations in the current application, 37 CFR 1.42 states, in part:

In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent.

37 CFR 1.497 states, in part:

- (a) When an applicant of an international application desires to enter the national stage under 35 U.S.C. 371 pursuant to 1.494 or 1.495, he or she must file an oath or declaration that:
 - (1) Is executed in accordance with either 1.66 or 1.68;

- (2) Identifies the specification to which it is directed;
 - (3) Identifies each inventor and the country of citizenship of each inventor; and
 - (4) States that the person making the oath or declaration believes the named inventor or inventors to be the original and first inventor or inventors of the subject matter which is claimed and for which a patent is sought.
- (b) (1) The oath or declaration must be made by all of the actual inventors except as provided for in 1.42, 1.43 or 1.47.
- (2) If the person making the oath or declaration is not the inventor, the oath or declaration shall state the relationship of the person to the inventor, the facts required by 1.42, 1.43 or 1.47, and, upon information and belief, the facts which the inventor would have been required to state.

The declarations filed 16 January 2001 fail to identify the correct inventive entity as required under 37 CFR 1.497(a)(3). Specifically, the second and third declarations only identify two of the six inventors named in the international application. The first declaration only identifies four of the six named inventors. Although the first declaration indicates that an additional form is attached thereto, it is unclear as to which of the attached forms this is referring to. Finally, the declarations fail to include the mailing address of the legal representatives, as required under 37 CFR 1.497(b)(2).

In addition, the indication of "Canada Trust" as an "inventor" on the declaration is improper.

Also, it appears that two persons signed for the legal representative, Canada Trust. However, the names of these persons are not listed and their signatures are illegible. In addition, the position of "Senior Trust Officer" and "Estate Counsellor," are positions not normally associated with having the authority to sign for a corporation and there is no statement claiming that these persons have the requisite authority to sign for Canada Trust. Such an express declaration by each agent is required.

Accordingly, the declaration is not acceptable under 37 CFR 1.497.

Applicants also included a copy of the "Letters Probate," and a copy of the "Last Will of Ian Alick Paterson" presumably as the proof of the authority under 37 CFR 1.44 of Canada Trust to sign as the legal representative of the deceased inventor. It is noted that proof of the authority of the legal representative in compliance with 37 CFR 1.44 is no longer required in the USPTO as of 08 September 2000.

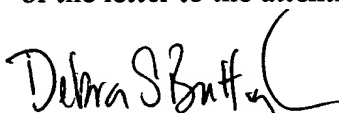
CONCLUSION

The Form PCT/DO/EO/916 and the Form PCT/DO/EO/917 are
VACATED.

Applicants' request under 37 CFR 1.42 is **DISMISSED** without prejudice.

If reconsideration of this decision is desired, a proper response, i.e., a declaration in compliance with 37 CFR 1.497(a)-(b), must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Request Under 37 CFR 1.42". Extensions of time may be obtained under 37 CFR 1.136(a). **FAILURE TO RESPOND WITH RESULT IN ABANDONMENT OF THE APPLICATION.**

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.



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